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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,200	11/20/2003	Marcus Dehlin	1988.68755	9819

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^{09/17/2008}

EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

09/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,200

Applicant(s)

DEHLIN ET AL.

Examiner

J. Gregory Pickett

Art Unit

3728

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9 and 11-13 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 July 2008 has been entered.

Claims 1 and 4-13 are pending in the application. Claims 2, 3, and 14-17 have been canceled.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

2. The declaration under 37 CFR 1.132 filed 14 July 2008 is insufficient to overcome the rejection of claims 1, 4-9, and 11-13 based upon Jones as set forth in the last Office action because:

In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert's opinion. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S.

1017 (1986). See also *In re Oelrich*, 579 F.2d 86, 198 USPQ 210 (CCPA 1978). The declaration does not provide any factual support for the opinion and amounts to a conclusion of the expert. Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). The presented expert opinion is contradicted by the evidence of record, where Casey (US 5,091,261) directly applies the polymer to the fiberboard base without the use of adhesive. Moreover, the presented expert is the inventor of the claimed invention and has a vested interest in the outcome of the prosecution. In light of all of the evidence on record, the declaration does not appear to be indicative of patentability. Affiant's reliance on "specialty films" is not commensurate in scope with either the claims, or the references applied.

However, upon updating the search for the case, a new reference has been found that goes more to the heart of the applicant's invention and position. This reference has been applied below. Although the rejection based upon Jones, alone, has been dropped, there should be no inference that the reference has been overcome.

Claim Rejections - 35 USC § 103

3. Claims 1, 4, 5, 7, 9, and 11 are rejected under 35 U.S.C. 103(a) as obvious over Jones et al (US 6,752,272 B2; hereinafter Jones) in view of Calvert et al (US 6,540,862; hereinafter Calvert).

Claim 1 is a product-by-process claim (see MPEP 2113).

Claims 1, 4: Jones discloses a child-resistant carton package comprising an outer sleeve **1**, an insert **3** carrying a packaged product, and a locking mechanism **13/24/25** or **10**. Jones anticipates a fiber-based board (paperboard) reinforced with a polymer to increase resistance to tearing (see Col. 4, lines 10-14 and Col. 6, lines 9-13). Jones anticipates an extrusion-laminated board (Col. 6, lines 23-25) which bonds the polymer directly to the fiber-based material. Jones anticipates polyester (see Col. 6, lines 16-19). Jones discloses "extrusion-laminating" the polymer instead of "extrusion coating".

Calvert teaches extrusion coating of a fiber-based material (paperboard 6) with a polyethylene terephthalate (PET) extrusion coated directly onto the paperboard material. Calvert teaches this procedure for reduced coat weights of the PET (Col. 1:15-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carton of Jones from the extrusion coated material as taught by Calvert in order to reduce the coat weights of the polymer. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 5: Jones anticipates coating on both sides (Col. 6, line 11).

Claim 7: Jones anticipates the coating on both the sleeve and the insert (Col. 4, lines 10-14).

Claim 9: The carton of Jones-Calvert is arranged as disclosed by the applicant, and is therefore inherently delaminable.

Claim 11: Jones discloses a hole when item **13** is depressed.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones-Calvert, as applied to claim 1 above, and further in view of Holbert et al (US 2003/0148110 A1; hereinafter Holbert).

Jones-Calvert discloses the claimed invention except for the inner reinforcement layer. Holbert discloses a paperboard/polymer laminate with an inner reinforcement layer **14**, which may be polyester (see paragraph [0021]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the board of Jones-Calvert with an inner reinforcement layer as taught by Holbert in order to improve tear resistance (see Holbert paragraph [0010]).

5. Claims 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones-Calvert, as applied to claim 1 above, and further in view of Schwenk (US 3,654,842).

Jones-Calvert discloses the claimed invention except for the polymer shield and heat-sealing with seam overlapping.

Schwenk discloses a polymer shield (Figure 5) and heat-sealing with seam overlapping (Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carton of Jones-Calvert by heat-sealing as taught by Schwenk in order to form a more durable bond.

Allowable Subject Matter

6. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

8. Applicant's arguments with respect to claims 1 and 4-13 have been considered but are moot in view of the new ground(s) of rejection.

Upon updating the search for the case, a new reference has been found that goes more to the heart of the applicant's invention and position. This reference has been applied above. Although the rejection based upon Jones, alone, has been dropped, there should be no inference that the reference has been overcome.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/
Primary Examiner, Art Unit 3728